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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | | |
|---|-------------|------------------------|---------------------|------------------|--|--|
| 10/082,677 | 02/25/2002 | Whitney Hilton Stewart | 025213-9075-00 | 6623 | | |
| 23409 | 7590 | 01/05/2010 | EXAMINER | | | |
| MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202 | | | | TRAN, HAI | | |
| ART UNIT | | PAPER NUMBER | | | | |
| 3694 | | | | | | |
| MAIL DATE | | DELIVERY MODE | | | | |
| 01/05/2010 | | PAPER | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/082,677 | STEWART ET AL. | |
| | Examiner | Art Unit | |
| | HAI TRAN | 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 November 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 48-80 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 February 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This is the Final Office Action in response to the Amendments filed on November 5, 2009 for application, titled: "Electronic Payment and Authentication System with Debit and Identification Data Verification and Electronic Check Capabilities".
2. Claims 1-47 were previously cancelled. Claims 48, 57-59, and 76 have been amended. New claims 77-80 have been added. Accordingly, claims 48-80 are pending in this application and have been examined.

Priority

3. This application claims the benefit of U.S. Provisional Patent Application No. 60/271,156, filed on February 23, 2001.

Claim Rejections - 35 USC § 101 (old)

4. Applicant has addressed the problem with claim 76. Hence, the rejection is withdrawn.

Claim Rejections - 35 USC § 101 (new)

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 48 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. In the present case, claim 48 recites a system claim in the preamble; however, there are no structural components like processor or apparatus defined in the claim body. The claim body recites "a calling application", "a debit data search engine", "a keying module", "a matching module", "a consumer key", and "a debit data warehouse" which are software.

8. An "application" is computer software designed to help a user to perform a particular task on a computer, or if it is a system application (system software), it is designed to integrate a computer's various capabilities. An "engine" can be referred to a core of a computer program that drives the functionality of the program. A "module" can be a collection of routines and data structures that perform a particular task. A "key" can be referred to a token or key provided to client computers in order to enable licensed software to run on client's computer. A "data warehouse" is a repository of an organization's electronically stored data designed to facilitate reporting and analysis.

9. Software are computer program per se and are not patentable under 35 U.S.C. 101. In order to overcome the rejection, Examiner suggests that the phrases be revised to say "a calling application configured on a computer to ..." or something similar.

Potential Allowable Subject Matter

10. Applicant's Amendment filed on November 5, 2009 and the interview held on October 28, 2009 have been carefully considered.

11. Applicant is advised to rewrite claim 48 to overcome the 35 U.S.C. 101 rejection in above in order for the claims to be patentable. Further, Applicant is informed that the

Amendment will be subjected to further search and pending on the search result, the patentability of the claims will be determined.

Conclusion

12. Claims 48-80 are rejected.
13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./
Examiner, Art Unit 3694

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694